

R E M A R K S

Claims 1-3 and 5-10 are pending in this application and stand ready for further action on the merits. Claim 4 has been canceled.

Support for new claim 6 can be found in claim 1 and in the first full paragraph of page 20 of the specification. Support for new claims 7-10 can be found in claims 2-5, respectively.

No new matter has been added by way of the above amendment.

The above amendment has not been made for the sake of patentability and/or does not narrow the scope of the invention.

Issues under 35 U.S.C. 103

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. US 5,967,908 (hereinafter the '908 patent) in view of Yamagishi et al. US 5,779,563 (hereinafter the '563 patent).

Inventive claim 1 recites that the golf ball contains a number of dimples in

a proportion R1 of number of dimples having a ratio (B/T), which is a ratio of a height B of a bottom of the dimple to a nominal thickness T of the cover, of equal to or less than 0.70 occupied in total number of the dimples is equal to or greater than 10%.

This feature gives the inventive golf ball at least one advantage over the golf balls of the prior art.

In an embodiment of the present invention, in the cover of this golf ball, there coexist sites with the ratio (B/T) being equal to or less than 0.70 and sites with no dimples present. The sites of which ratio (B/T) being equal to or less than 0.70 are responsible for the resilience performance of the golf ball. The sites with no dimples present are responsible for the control performance of the golf ball on behalf of a synergistic effect with the thermoplastic polyurethane elastomer. This golf ball is excellent in both terms of a control performance and a resilience performance.

Based on the Examiner's comments in the outstanding Office Action, it appears that the Examiner is relying upon the '908 patent for teaching the feature of inventive R1. Upon close review of the '908 patent, Applicants respectfully submit that the Examiner's calculations for R1 are incorrect.

The Examiner relies on the values in Table 4 of the '908 patent for calculating R1. In this Table, the thickness of the cover of the golf balls for each of the Examples and Comparative Examples is 1.5 mm.

For Example 1, the '908 patent teaches that the golf ball has a dimple type "I." By taking the values described in Tables 3 and 4 of the '908 patent, Applicants calculate that R1 of Example 1 of the '908 patent is 0% as follows:

Example 1

Dimple type	1			
Thickness of cover T (mm)	1.5			
Diameter (mm)	4.00	3.60	3.25	2.45
Depth D (mm)	0.175	0.150	0.140	0.125
Number	276	24	60	36
B=T-D (mm)	1.325	1.350	1.360	1.375
(B/T)	0.88	0.90	0.91	0.92
Total Number	396			
R1 (%)	0			

The above Table shows that there is no dimple that has a ratio (B/T) of equal to or less than 0.80. Accordingly, the ratio R1 becomes 0%.

The Examiner will note that incorporating the values of depth for dimple types II and III as used in Examples 2-4 of the '908 patent, a similar finding of R1 = 0% can be made.

According to MPEP § 2143.03, the cited references must teach or fairly suggest all of the claimed elements for a *prima facie* case of obviousness. Since the '908 patent, either alone or in combination with the '563 patent, neither teach nor fairly suggest the inventive R1 value, Applicants respectfully submit that the present claims are patentable over the combination of the '908 patent or the '908 patent and the '563 patent.

Accordingly, withdrawal of the rejection is respectfully requested.

Double Patenting

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of co-pending Application No. 10/373,100 (the '100 application) in view of the '563 patent. Applicants respectfully traverse the rejection.

As the Examiner has noted, a difference between the inventive golf ball and the golf ball claimed in the '100 application, is that the inventive golf ball requires a cover having a base polymer, which includes a thermoplastic polyurethane elastomer as the principal component. In order to cure this deficiency, the Examiner cites the '563 patent.

Applicants respectfully submit that the inventive golf ball containing a cover comprising a base polymer, including a thermoplastic polyurethane elastomer as the principal component, has unexpectedly superior properties to the golf ball of the '100 application. This is clear from the experimental data in the present specification.

The following table gives the data from Table 5 on page 28 of the present specification for the Examiner's convenience.

	Example 1	Example 3	Com. Example 3	Com. Example 4
Principal component of cover *1	U	U	I	I
Scuff resistance	A	A	B	C
Control Performance	A	A	C	B

*1 U: Thermoplastic polyurethane elastomer
I: Ionomer resin

As can be seen from the above data, the inventive golf ball, which comprises a polyurethane elastomer as the principal component in the cover, has superior control performance and resilience performance, when compared to the golf ball claimed in the '100 application. Based on the teachings of the '563 patent, this improvement would not be expected by the skilled artisan.

In view of these unexpected results, Applicants respectfully submit that the inventive claims are not obvious over the claims of the '100 application in view of the '563 patent. Accordingly, Applicants respectfully request that the obviouness-type double-patenting rejection be withdrawn.

DRAWINGS

Applicants note that the present application was filed with four (4) sheets of formal drawings. However, the Examiner has not acknowledged whether the drawings are acceptable.

Applicants respectfully request that the Examiner indicates in the next communication whether the drawings are acceptable.

Notice of References Cited (PTO-892 Form)

Applicants note from the PTO-892 Form, which was enclosed with the outstanding Office Action, that the Examiner cited Ohama et al. (US Application Publication No. 2003/0186761 and Sajima et al. (US Application Publication No. 2003/0162609). However, the Examiner has not indicated why these references were cited.

Applicants respectfully request that the Examiner indicates why these references were cited for clarity of the record.

Conclusion


In view of the above amendments and comments, Applicants respectfully submit that the claims in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43,575) at the telephone number of the undersigned below.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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ADM/GMD:bmp
367-0153P

(Rev. 02/12/2004)